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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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Janne Parantainen

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EXAMINER

STEPHEN, EMEM O

ART UNIT

PAPER NUMBER

2617

MAIL DATE

DELIVERY MODE

12/02/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/529,705	PARANTAINEN, JANNE	
	Examiner	Art Unit	
	EMEM STEPHEN	2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11/10/08.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless —(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 3, 7-9, 12-15, 19, 23, 26-30, 33-36, 39-47, 51-52, and 54-58 are rejected under 35 U.S.C. 102(b) as being anticipated by US Pub. No. 20060189272 A1 to Willenegger et al.

Regarding claims 1, 15, and 23, 30, 33, 47, and 51, Willenegger discloses a terminal, a network element, a system and a method comprising: transmitting, by a network element in a wireless communication system (see figs. 1-2, and par. 14), a broadcast or multicast message indicating terminal capability requirements (user specific data transmission) for point-to-multipoint MBMS service reception in a wireless system over an air interface to at least one terminal within the service range (pars. 8-9, 25, 27-29, and 109) in order to allow the terminal to determine whether it is capable of receiving the service or not (pars. 74-80, 198, 232-238, and 264), said requirements being indicated in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class (par. 96).

Regarding claim 3, Willenegger discloses the method of claim 1, wherein it further comprises a step wherein said requirements for receiving the service are defined (par. 233).

Regarding claims 7-9, 27, 29, and 39-41, Willenegger discloses wherein said system is substantially GSM /GPRS or UMTS system (par. 23).

Regarding claims 12-14, 26, 28, 34, 42-46, and 52, Willenegger discloses wherein said message is substantially a schedule message, characterized in that said schedule message is CBS service specific (par. 137).

Regarding claims 19, Willenegger discloses the method of claim 15, wherein said informed data indicates at least one of the following features supported by said terminal: time slot configuration, modulation type, bit rate, and capability class (par. 96).

Regarding claims 35-36, and 54, Willenegger discloses wherein said network element further comprises means for receiving said requirements for point-to-multipoint service reception prior to sending said message indicating said requirements (see fig. 2, and pars. 27-30).

Regarding claims 55-58, Willenegger discloses a computer readable medium stored with machine-readable instructions that upon execution by a programmable apparatus (par. 14) make the apparatus receive a message indicating requirements for point-to-multipoint Multimedia Broadcast/Multicast Service service reception (pars. 22-23) and further to determine on the basis of said requirements whether it is capable of receiving the service or not (pars. 74-80, 232-238, and 264), said requirements indicated in relation to at least one of the following: time slot configuration, modulation type, bit rate, and capability class (par. 96).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 2, 4-6, 11,16, 20, 24-25, 37-38, 48, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willenegger in view of US Patent No. 6,600,917 B1 to

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Maupin.

Regarding claims 2, 4-6, 11, 16, 20, 24-25, 37-38, 48, and 53, Willenegger discloses the method of claim 1, however, fails to specify wherein a decision of whether to receive the service or not is made in the terminal on the basis of said indication. Maupin discloses wherein a decision of whether to receive the service or not is made in the terminal on the basis of said indication (col. 8 line 47-col. 9 line 8), wherein further comprises a step wherein the service-related data is transmitted in conformity with indicated requirements (col.9 lines 8-55), wherein said requirements are indicated in said message implicitly with an identifier associated to a certain set of requirements (see fig. 5), wherein said requirements are indicated in said message explicitly with parameters (see figs. 4-5), message sent by the Center cell broadcast centre or radio network controller/base station controller (col. 6 lines 12-18). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the disclosure of Maupin in the invention of Willenegger for the purpose of the terminal making a decision as to whether to receive service based on obtained information.

5. Claims 17-18, 21-22, 31-32, and 49-50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Willenegger in view of US Pub. 2002/0071480 A1 to Marjelund.

Regarding claims 17-18, 21-22, 31-32, and 49-50, Willenegger discloses the method above, however, Willenegger fails to specifically disclose wherein said wireless communication system is substantially GSM/GPRS or UMTS system, wherein said informing is performed over a radio access network that is substantially GERAN or

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UTRAN, and wherein said point-to-multipoint service is substantially a multicast service, characterized in that the air interface in said system is substantially in accordance WLAN specifications. Marjelund disclose wherein said system is substantially GSM GPRS or UMTS system, wherein said informing is performed over a radio access network that is substantially GERAN or UTRAN, and wherein said point-to-multipoint service is substantially a multicast service, wherein the air interface in said system is substantially in accordance WLAN specifications (see fig. 1, the use multicast service and WLAN are well known in the art). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use the invention of Willenegger in the system of Marjelund for the purpose of meeting with the user's preference.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to EMEM STEPHEN whose telephone number is 571 272 8129. The examiner can normally be reached on 8-5 Mon-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Appiah can be reached on 571 272 7904. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ES
11/24/2008

/Charles N. Appiah/
Supervisory Patent Examiner, Art Unit 2617